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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002.062	10/30/2001	Shell S. Simpson	10007669-1	8476

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

POWERS, WILLIAM S

ART UNIT	PAPER NUMBER
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2134

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/002,062	Applicant(s) SIMPSON ET AL.	
	Examiner William S. Powers	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


RAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on 12/11/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


KAMBIZ ZAND
PRIMARY EXAMINER

Claim Objections

2. Claim 1 is objected to because of the following informalities: the claim recites the limitation "said browser" in line 4. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. As to claims 9 and 16, it is unclear from the claim language or the specification how the secure transmission of data can be equivalent to securely printing data.

Additionally, it is unclear how an option can exist to securely transmit data when the independent claims already securely transmit that data. In both independent claims 1 and 12, the image data is encrypted with the public key of the destination web service and transmitted to the destination web service. There is not an option to not securely transmit data.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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9. Claims 1-10, 12-16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,151,675 to Smith in view of US Patent No. 5,721,908 to Lagarde et al. (hereinafter Lagarde).

As to claim 1, Smith teaches:

- a. Accessing a destination web service (dynamic document conversion server) (Smith, column 5, lines 34-36).

Smith uses the Internet to communicate between the user and server, but does not expressly mention the use of a browser. However, in an analogous art, Lagarde teaches:

- b. Downloading into said browser (Lagarde, column 9, lines 10-11) web content associated with said accessed destination web service (Lagarde, column 10, lines 12-29).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the secure document transmitting of Smith with the browser of Lagarde in order to affect web server data access over the Internet as suggested by Lagarde (Lagarde, column 1, lines 15-20).

Smith as modified further teaches:

- c. Downloading a public encryption key into said browser from said accessed destination web service (Smith, column 6, lines 28-30, figure 2A and column 3, lines 27-32).

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- d. Retrieving image data under control of said browser (Lagarde, column 5, lines 16-24).
- e. Encrypting said retrieved image data, wherein said downloaded public encryption key is utilized as part of said encrypting step (Smith, column 6, lines 28-30):
- f. Transmitting said encrypted image data to said accessed destination web service (Smith, column 6, lines 31-32).
- g. Decrypting said encrypted image data by said accessed destination web service, wherein a private encryption key counterpart of said public encryption key is utilized as part of said decrypting step, said private encryption key being accessible exclusively to said accessed destination web service (Smith, column 6, lines 38-40).

As to claim 2, Smith as modified teaches said retrieved image data is previously referenced to a composition associated with said user's identity (Lagarde, column 13, lines 34-40).

As to claim 3, Smith as modified teaches said accessed destination web service represents a production device (Smith, column 5, lines 7-13 and figure 1).

As to claim 4, Smith as modified teaches said production device is a printer (Smith, column 5, lines 7-13 and figure 1).

As to claim 5, Smith as modified teaches said retrieving comprises accessing said user's identity from said destination web service via said web content through an imaging extension (Lagarde, column 12, lines 29-39).

As to claim 6, Smith as modified does not expressly disclose a hard disk. However, Official Notice is given that it is well known that modern computer systems employ hard disks as secondary memory.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Smith as modified using a hard disk for secondary memory.

As to claim 7, Smith as modified teaches said image data is contained in a PDF file (Smith, column 5, lines 46-56).

As to claim 8, Smith as modified teaches choosing desired options represented by said destination web service through said web content (Lagarde, column 10, lines 37-41).

As to claim 9 as best understood by the Examiner, Smith as modified teaches securely transmitting data (Smith, column 6, lines 31-32).

As to claim 10, Smith as modified teaches creating a print job reflecting said desired options, said print job including said image data (Lagarde, column 14, line 62-column 15, line 32).

As to claim 12, Smith as modified teaches:

- a. Accessing a destination web service (dynamic document conversion server) (Smith, column 5, lines 34-36).
- b. Download web content from said destination web service to a user's browser (Lagarde, column 9, lines 10-11 and column 10, lines 12-29).
- c. Download a public encryption key from said destination web service (Smith, column 6, lines 28-30, figure 2A and column 3, lines 27-32).
- d. Encrypt imaging data using said public encryption key as part of encryption process (Smith, column 6, lines 28-30).
- e. Transmit said encrypted imaging data to said destination web service (Smith, column 6, lines 31-32).
- f. Direct said destination web service to decrypt said encrypted imaging data using a private encryption key counterpart of said public encryption key as part of decryption process, said private encryption key being accessible exclusively to said destination web service (Smith, column 6, lines 38-40).

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As to claim 13, Smith as modified teaches said imaging data is previously referenced to a composition associated with a user's identity (Lagarde, column 13, lines 34-40).

As to claim 14, Smith as modified teaches said destination web service represents a production device (Smith, column 5, lines 7-13 and figure 1).

As to claim 15, Smith as modified teaches directing said destination web service via said web content to select production options for producing said imaging data by said production device (Lagarde, column 14, line 62-column 15, line 32).

As to claim 16 as best understood by the Examiner, Smith as modified teaches securely transmitting data (Smith, column 6, lines 31-32).

As to claim 18, Smith as modified teaches:

- a. A user's browser (Lagarde, column 9, lines 10-11) operable to encrypt image data using a first encryption key as part of the encryption process (Smith, column 6, lines 27-39).
- b. Transmitting said encrypted data image (Smith, column 6, lines 27-39).
- c. A destination web service representing a production device (Lagarde, column 15, lines 15-22).

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d. Said web service operable to download said first encryption key into said user's browser (Smith, column 6, lines 28-30, figure 2A and column 3, lines 27-32).

e. Said web service operable to receive said transmitted encrypted image data and to decrypt said received image data using a private encryption key counterpart of said first encryption key (Smith, column 6, lines 27-39).

f. A data path interconnection said user's browser with said destination web service (Lagarde, column 9, lines 18-26).

As to claim 19, Smith as modified teaches said production device is a printer (Smith, column 5, lines 7-13 and figure 1).

As to claim 20, Smith as modified teaches said data path is selected from the group consisting of hard wired data paths and wireless data paths (Lagarde, column 9, lines 18-26).

As to claim 21, Smith as modified teaches said first encryption key is a public encryption key (Smith, column 4, lines 45-51).

10. Claims 11, 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,151,675 to Smith in view of U.S. Patent No. 5,721,908 to

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Lagarde et al. (hereinafter Lagarde) in further view of Applied Cryptography by Bruce Schneier.

As to claims 11, 17 and 22, Smith as modified teaches security measures, but does not expressly mention the use of a session key. However, in an analogous art, Schneier teaches "a hybrid cryptosystem" (page 33, 5th paragraph) wherein a session key is generated that encrypts the data, uses the public key of the recipient to encrypt the session key and sends the session key and data to the destination where the private key counterpart decrypts the session key and the session key decrypts the data (page 33, paragraphs 6-9) in order to more effectively use the computer system resources.

Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention was made to institute the session key encryption scheme, as disclosed by Schneier, as this better utilizes computer resources.

Conclusion

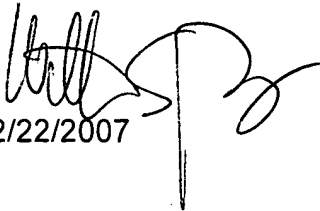
The new grounds of rejection are based on the recommendations of the appeal conferees SPE Eddie Lee and Primary Examiner Taghi Arani.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers whose telephone number is 751 272 8573. The examiner can normally be reached on m-f 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zand Kambiz can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



2/22/2007

William S. Powers
Examiner
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3PE 2134